UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,488	04/09/2001	Michael Majeed	17200-800	8072

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EXAMINER
POND, ROBERT M

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/829,488	MAJEED, MICHAEL
	Examiner	Art Unit
	Robert M. Pond	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 August 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-107</u> is/are pending in the application.

    4a) Of the above claim(s) <u>52-75</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-51 and 76-107</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>19 July 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

The Examiner found species arguments as being persuasive. All pending claims

not withdrawn (1-51 and 76-107) were examined in this non-final office action.

Specification

1.   The specification has not been checked to the extent necessary to determine

the presence of all possible minor errors. Applicant's cooperation is requested in

correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

2.   Claims 79-88 are rejected under 35 U.S.C. 112, second paragraph, as being

incomplete for omitting essential elements, such omission amounting to a gap

between the elements. See MPEP § 2172.01. The omitted elements are: active

step of utilizing data to produce a tangible result. Claim elements only define data

as non-functional descriptive language.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   **Claims 18-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The Applicant is claiming program product in a computer readable medium. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature that constitute "descriptive material." Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs that impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most

cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir.1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the art to which said subject
> matter pertains. Patentability shall not be negatived by the manner in which the invention was
> made.

4.   **Claims 1, 4-7, 9-11, 18, 21-24, 35, and 38-41 are rejected under 35 USC**

103(a) as being obvious over Prime Response, Inc. (a collection of prior art

cited in PTO-892, Items: U and V, hereinafter referred to as "PRI") in view of

IQ Software (PTO-892, Item: W, hereinafter referred to as "IQS").

PRI teaches Priceline.com deploying Prime Response's Prime@Vantage

software to enhance its name-your-own-price services for airline tickets, hotels

rooms, home mortgages, and new cars (U: see at least pages 1 and 2). PRI

teaches Priceline.com collecting consumer demand information and presenting

the demand information to sellers who can fill as much of that demand as they

want at price points determined by the buyers (please note examiner's

interpretation: buyer's name-your-own-price is conditional and pending at this

point in time) (U: see at page 2). PRI teaches Prime Response's

Prime@Vantage and Information Advantage's Business Intelligence software,

DecisionSuite and MyEureka! Business intelligence portal, combining strengths

to introduce to the industry an integrated data analysis and campaign

management solutions designed to scale to the enterprise (V: see at least pages

1 and 2). PRI teaches services being offered to DynaMark to provide a single comprehensive solution combining automated campaign management and advance Web-based analysis (V: see at least pages 1 and 2). PRI teaches marketers (please note: DynaMark and Priceline.com represent marketers) using the Prime Response/Information Advantage integrated solution being able to leverage customer behavior analysis capabilities with robust marketing campaign automation. PRI further teaches their combined technology enabling DynaMark with a competitive edge via Web-based analysis and quick reaction to market trends (V: see page 2). PRI further teaches:

- *Buyer-specified offer prices for goods or services:* conditional purchase offer data from buyers presented to a seller (U: see at least page 2).

- *Populating a database with collected commerce information:* Inherent in PRI are the structures necessary to populate a database with collected commerce information. For example, PRI teaches priceline.com and DynaMark systems conducting commerce transactions with customers and sellers.

- *Pending conditional purchase offer data:* Priceline.com collecting consumer demand information and presenting the demand information to sellers who can fill as much of that demand as they want at price points determined by the buyers (please note examiner's interpretation: buyer's name-your-own-price is conditional and pending at this point in time) (U: see at page 2).

- *Accepted or rejected conditional purchase offers:* Priceline.com collecting

  consumer demand information and presenting the demand information to

  sellers who can fill as much of that demand <u>as they want</u> (please note

  examiner's interpretation: at least will either accept or reject a pending

  conditional purchase offer) (U: see at page 2).

- *Computer program:* Inherent in PRI are the structures necessary to permit

  the execution of a computer program. For example, a computer processor

  and memory are necessary to execute software applications disclosed in

  PRI.

PRI teaches all the above as noted under the 103(a) rejection and teaches a)

conditional purchase offers from buyers as business information used by a seller

to make a business decision, b) marketers leveraging customer behavior

analysis with marketing campaign automation using the Prime

Response/Information Advantage integrated solution, and c) sharing customer

and campaign information across the enterprise and responding quickly to

market trends, but does not disclose generating a demand report. IQS teaches

integrating Information Advantage's Eureka! Products with IQ Software's

integrated line of enterprise reporting products to deliver business intelligence

from transaction reporting to multidimensional analysis through a personalized

Web portal. IQS teaches IQ Software's IQ/SmartServer as being a multi-threaded

report server that off-loads report execution and teaches scheduling options and

the ability to execute reports dynamically for up to the second information. IQS

further teaches user defined report levels that are either pre-processed or

executed on-demand (W: see pages 1 and 2). Therefore it would have been

obvious to one of ordinary skill in the art at time of the invention to modify the

method of PRI to implement on-demand dynamic report generation for marketers

utilizing customer business information as taught by IQS, in order to permit

marketers to analyze customer behavior and market trends on-demand, and

thereby attract marketers to the service desiring report generation pertaining to

conditional purchase offers.

PRI teaches all the above as noted under the 103(a) rejection and teaches

but does not specifically disclose receiving a request specifying criteria for

selecting collected commerce information. IQS teaches all the above as noted

under the 103(a) rejection. Inherent in IQS are the structures necessary to permit

requesting criteria for selecting collected commerce information. For example,

IQS teaches Smartserver delivering business intelligence from transaction

reporting to multidimensional analysis through a personalized Web portal based

on user defined report levels that are either pre-processed or executed on-

demand (W: see pages 1 and 2). Therefore it would have been obvious to one of

ordinary skill in the art at time of the invention to modify the method of PRI to

implement requesting criteria for selecting commerce information as taught by

IQS, in order to permit marketers to produce relevant business reports, and

thereby attract marketers to the service desiring report generation pertaining to conditional purchase offers.

Pertaining to computer program claims 18 and 21-24

Rejection of claims 18 and 21-24 is based on the same rationale as noted above.

Pertaining to apparatus claims 35 and 38-41

Rejection of claims 35 and 38-41 is based on the same rationale as noted above.

5. **Claims 2, 8, 12-17, 19, 25-34, 36, 42-51, 79-92, and 94-97 are rejected under 35 USC 103(a) as being obvious over PRI (a collection of prior art cited in PTO-892, Items: U and V) in view of IQS (PTO-892, Item: W), as applied to claims 1, 18, 24, 35, and 41, further in view of Walker (US 6,041,308).**

PRI and IQS teach all the above as noted under the 103(a) rejection and teach a) buyers submitting conditional purchase offers as business information to Priceline.com and Priceline.com using Prime Response's Prime@Vantage product, b) Prime Response and Information Advantage combining their strengths (i.e. Prime@Vantage and DecisionSuite/MyEureka!) to provide business intelligence for client decision-makers, and c) integrating on-demand dynamic report generation into DecisionSuit/MyEureka! products to provide business intelligence from transaction reporting to multidimensional analysis

through a personalized Web portal based on user defined report levels that are

either pre-processed or executed on-demand using business data relevant to the

business. PRI and IQS, however, do not disclose specifics about the types of

business intelligence criteria for report generation. Walker teaches the system

and method of Priceline.com's conditional purchase offering system and

business information managed by the CPO Management System (see at least

abstract; col. 1, line 15 through col. 2, line 32). Walker further teaches the

following business data relevant to the business of processing conditional

purchase offers managed by the CPO Management System:

- *Targeted demand:* forecasted demand (see at least col. 1, lines 60-62).

- *Strike price:* minimum price required by seller for a particular CPO (see at least Fig. 6 (655); col. 8, lines 32-40).

- *Accepted CPOs:* completing a CPO transaction by seller accepting a CPO stored in the system (see at least abstract; col. 2, lines 3-21).

- *Rejected CPOs:* percentage of buyers will submit purchase offers that are not acceptable to any seller (see at least col. 2, lines 3-7).

- *Expired CPO:* (see at least col. 4, lines 13-16); air travel data range (times or days or airline) (see at least col. 6, lines 3-14).

- *Historical demand:* buyer history database (see at least Fig. 4 (400); col. 7, line 62 through col. 8, line 10).

- *Specific seller for specific CPO:* each CPO identified by unique CPO identifier and associated with the seller identified by unique seller identifier (see at least Fig. 6 (645).

- *Pending, rejected, expired:* CPO status conditions (see at least Fig. 5 (575)).

- *Login information:* Inherent in Walker are the structures necessary to permit determination of login information. For example, Walker discloses assigning a unique identifier to a buyer and assigning a unique ID to a seller; account information associated with a buyer.

- *Data structures:* Inherent in Walker are the structures necessary to define and organize business data in memory. For example, Walker discloses buyer databases, seller databases, and other CPO management databases for storing business data (see at least Fig. 2 (300, 400, 500, 600, 700, 800, 900); Fig. 3 (300); Fig. 4 (400); Fig. 5 (500); Fig. 6 (600); col. 4, lines 52-65).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of PRI and IQS to disclose business information relevant to the processing of conditional purchase offers as taught by Walker, in order to generate up-to-the minute on-demand reports pertaining to CPO management, and thereby attract sellers desiring dynamic report generation for business decision-making.

Pertaining to computer program claims 19 and 25-34

Rejection of claims 19 and 25-34 is based on the same rationale as noted above.

Pertaining to apparatus claims 36, 42-51, and 79-92

Rejection of claims 36, 42-51, and 79-92 is based on the same rationale as noted above.

6.   **Claims 3, 20, 37, 76-78, 93, and 98-107 are rejected under 35 USC 103(a) as being obvious over PRI (a collection of prior art cited in PTO-892, Items: U and V), IQS (PTO-892, Item: W), and Walker (US 6,041,308), as applied to claims 2, 19, 36, and 89, further in view of Official Notice (regarding old and well-known in the arts).**

PRI, IQS, and Walker teach all the above as noted under the 103(a) rejection and teach a) buyer's submitting conditional purchase offers to sellers via Priceline.com (PRI, Item: U), b) sellers deciding what conditional purchase offers to accept (PRI, Item: U; Walker), c) experiencing seller situations where actual demand fails to meet forecasted demand and sellers establishing a minimum acceptance price (i.e. strike price) (Walker), and d) rewarding rejected buyers with incentives (e.g. discount coupons, cash award) (Walker). The Examiner takes the position that it is notoriously old and well-known in the arts for sellers to either determine a lower minimum selling price to increase sales demand to targeted levels or to determine a minimum selling price to better control sales to

better meet supply. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of PRI, IQS, and Walker to disclose business information relevant to the processing of conditional purchase offers as taught by Walker, in order to generate up-to-the minute on-demand reports pertaining to CPO management, and thereby attract sellers desiring dynamic report generation for business decision-making.
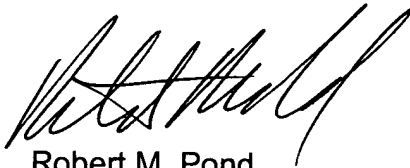
Pertaining to system claims 76-78

Rejection of claims 76-78 is based on the same rationale as noted above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert M. Pond
Primary Examiner
November 14, 2005